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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,894	06/14/1999	ARSHISH Cyrus KAPADIA	0544MH-3426	4656

7590 10/30/2003

ATTEN: CHRISTOPHER W. KENNERLY, ESQ.
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EXAMINER	
FADOK, MARK A	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/333,894	KAPADIA ET AL.	
	Examiner	Art Unit	
	Mark Fadok	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 August 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 6-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Request for Reconsideration

The examiner is in receipt of applicant's response to Office action mailed 8/1/2003 and received 8/25/2003. Acknowledgement is mad that no new claims were added and that none of the claims were amended. The applicant's arguments have been carefully considered, but were not found to be persuasive; therefore the previous rejection is restated below:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 and 6-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Rhythm (a series of pages from I2 technologies web site dated 5/26/1998).

In regards to claims 1-4 and 6-43, Henson teaches all of the features of the instant claims except as follows:

Henson teaches a method and apparatus for configuring products over the Internet using a configurator, but does not specifically mention some of the dynamically applied optimization features from the instant claims. Rhythm teaches an order promise solution that allows the sales organization to have global visibility and allows large-scale

ERP order management systems to provide accurate quotes in real time. The system allows companies to model and implement their business rules using a wide range of constraint to achieve optimization. It would be obvious to a person of ordinary skill in the art to include in Henson the optimization capabilities offered by Rhythm, because this would increase the likelihood of promised delivery dates being met and increase customer satisfaction.

Response to Arguments

Applicant's arguments filed 8/25/2003 have been fully considered but they are not persuasive.

Applicant argues that the combination of Henson and Rhythm does not teach some of the features listed in the independent claims. The examiner disagreed and provided the following supporting information for each claimed unique feature;

- During a product configuration session (Henson FIG 1)
- For each of a series of selection options sets (Henson FIG 3)
- Dynamically applying an optimization function with respect to each item in the selection option set (Rhythm, page 7),
- According to data received from an available to promise engine during the product configuration session (Rhythm, page 3 and 4)
- To identify an item of the selection option set as a default selection (Rhythm, page 19)

- The default selection being optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function (Rhythm, page (7, 18 and 19)
- (claim 7) during the configuration session (Henson, FIG 3A)
- (claim 8) in response to an identification of the user during the configuration session (Rhythm, page 17, user preferences, Henson col 3, lines 7-11)
- (claim 9) in response to a product selection decision made by the user during the configuration session (Henson, col 3, Rhythm, page 16 and 17)

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Henson teaches ordering a product configured over the internet by a user with the aid of a site configurator that can alert the user when a long lead item is being selected which will impact the delivery of the configured product (see at least col 3) and Rhythm teaches a system for improving the provided information concerning schedule and deliver (page 3).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that Henson teaches presenting the user with all options and remains free to at least initially select any of the options (see FIG 4), whereas applicant's invention has the distinguishing feature of "*for each selection option set, before presenting the selection option set to the user, determining which of the selection option sets are actually available to the user in accordance with a user-specified date constraint and presenting only those items of the selection option set which are actually available to the user in accordance with the user-specified date constraint.*"

In response to applicant's arguments against the reference of Henson individually, one cannot show nonobviousness by attacking a reference individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case Henson teaches dynamically adjusting a products configuration and presenting a warning if the selected option does not comply

with a designated delivery time (Henson, col 3). The system is improved when the capabilities of Rhythm are added to present an optimized product configuration (Page 16, auto resolution and see also pages 3,4 and 19 Available To Promise (ATP)).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Mark Fadok

Patent Examiner

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
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